

REMARKS/ARGUMENTS

Reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the remarks that follow. Claims 1, 3-10, 12-17, 19-26, and 28-36 are pending in the application. Claims 1, 17, and 33 are independent claims.

Claims 1, 3-5, 7-10, 12-16, 33, and 35-36 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,129,408 to Jakob *et al.* The Examiner alleges that the Jakob patent teaches a cigarette comprising a smokable material, wherein the smokable material includes some form of tobacco in intimate contact with aerosol forming materials. Applicants respectfully traverse this rejection.

In order to anticipate a claim, the cited reference must teach each and every limitation of the claims. Independent claim 1 recites an aerosol forming material in intimate contact with a processed tobacco material that is processed such that at least a portion of a solvent soluble portion of the tobacco material is removed therefrom and such that the processed tobacco material is a substrate for the aerosol forming material. Similarly, independent claim 33 recites an aerosol forming material in intimate contact with a reconstituted tobacco material. The cited patent clearly fails to teach or suggest at least the above-referenced limitations of the independent claims implicated in this rejection.

The Jakob reference cited in the Office Action describes the use of a smokable material that comprises tobacco and an agglomerated matrix filler comprising an organic component and an inorganic component (column 2, lines 50-59). The agglomerated matrix filler is not a tobacco material, but rather includes organic components such as alginate combined with inorganic components such as calcium carbonate. Where the Jakob reference describes inclusion of aerosol-forming materials, it is in the context of forming a mixture of such materials with the agglomerated matrix filler, not a reconstituted tobacco material. For instance, one preferred type of smokable filler material described in column 5, wherein it is indicated that an aerosol forming material can be included in the agglomerated matrix filler. At the end of column 5 and carrying over into column 6, the patent describes preferred compositions of such agglomerated matrix

fillers, specifically noting that such materials can include a 3-15 weight percent aerosol forming material. There is absolutely nothing in the Jakob patent suggesting the formation of an intimate mixture of an aerosol forming material and a reconstituted tobacco such that the reconstituted tobacco is a substrate for the aerosol forming material.

The examples provided in the Jakob patent further highlight the stark differences between the teachings of the reference and the claimed invention. In Example 1, glycerin is charged into a water/alginate mixture that is later combined with an agglomerated calcium carbonate to form the smokable filler material described in the patent. Similarly, in Example 2, particles of calcium carbonate agglomerated with an alginate are provided by charging water and glycerin into a blender and thereafter adding ammonium alginate and calcium carbonate. Similarly, in Example 3, a smokable filler material is formed by charging tap water and ammonium alginate into a blender with glycerin. Thereafter, agglomerated calcium carbonate is added to the slurry. In all examples, the glycerin is not placed in intimate contact with a reconstituted tobacco material. Instead, the glycerin contacts the agglomerated matrix filler. There is no description of an intimate mixture of an aerosol forming material with a reconstituted or processed tobacco material.

Thus, it is clear that, when considered in its entirety, the Jakob patent fails to teach the formation of an intimate mixture of a reconstituted tobacco and an aerosol forming material. Instead, the clear intent in the Jakob patent is to incorporate aerosol forming materials into the agglomerated matrix filler. Every example in the patent that includes incorporation of an aerosol forming material shows the inclusion of such materials during processing of the agglomerated matrix filler. Thus, there is simply nothing to lead one of ordinary skill in the art to combine, in intimate mixture, an aerosol forming material and a reconstituted tobacco that has been processed to remove a soluble portion such that the processed tobacco material provides a substrate for aerosol forming material. As taught in Applicants' specification, it has been surprisingly discovered that incorporating an aerosol-forming material into reconstituted tobacco can provide greatly increased loading of the aerosol-forming material as compared to more conventional methods of adding such materials to tobacco. This aspect of the invention is simply

not described in the cited reference. In light of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 6, 17, 19-26, 28-32, and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed Jakob patent. The Examiner admits that the Jakob reference does not specifically teach the use of wrapping materials having an inherent porosity of at least about 15 CORESTA, but states that it would have been obvious to use such wrapping materials because they are well known and readily available in the market. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As an initial point, Applicants note that the Jakob patent fails to teach or suggest all of the limitations of independent claims 1 and claim 33 as explained above. Accordingly, since many of the claims implicated in this rejection depend from claim 1 or claim 33, it follows that this rejection should also be overcome as applied to those claims.

The Jakob patent specifically notes in the background section that it would be desirable to provide a cigarette generating low levels of sidestream “tar” and low levels of visible sidestream smoke. The Jakob reference also indicates that a desirable quality for cigarettes is the ability to sustain smolder during FTC smoking conditions. In the summary section of the patent, the Jakob reference specifically states that preferred wrapping materials are low air permeability paper wrappers, such as paper wrappers having a porosity below about 5 CORESTA units (see column 2, lines 20-27 and 40-45). In column 12, the Jakob reference specifically notes that cigarettes incorporating low porosity paper outer wrappers having the propensity to sustain smolder when smoked under FTC smoking conditions (column 12, line 63 – column 13, line 3). The

preference for low permeability papers is again stressed in column 13, wherein the patent suggests wrapping materials having a permeability of less than about 5 CORESTA units (column 13, lines 48-53). Still further, the Jakob reference describes methods for obtaining such low porosity levels, such as by incorporating a polymeric film forming agent into the paper. In column 14, the Jakob reference suggests incorporating the polymeric film forming agent in order to achieve a porosity of less than 1 CORESTA unit. In Example 1 of the patent, the Jakob reference describes the use of a wrapping material exhibiting 0 CORESTA unit.

Thus, the reference does not simply express a preference for such materials, but clearly indicates that the use of very low porosity wrapping materials is advantageous in order to achieve the desired goals set forth in the patent. As a result, Applicants respectfully submit that the Examiner has failed to adequately explain how one of ordinary skill in the art would find the requisite motivation to ignore the repeated teachings in the Jakob patent to utilize very low CORESTA materials in order to arrive at the invention set forth in various pending claims, such as those claims specifically reciting wrapping materials having a porosity of at least 15 CORESTA units, which is three times the upper limit set forth repeatedly in the Jakob patent. The mere fact that such materials are known in the art and available is not sufficient to motivate one of ordinary skill in the art to modify the teachings of the Jakob patent, particularly where such a strong preference for very low porosity materials is expressed throughout the reference. In light of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection.

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Amdt. dated January 31, 2007
Reply to Office Action of October 31, 2006

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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